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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,403	12/20/2001	Ian Keith Hatton	P32162C1	6756

7590 08/23/2005

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EXAMINER

DAVIS, ZINNA NORTINGTON

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,403

Applicant(s)

HATTON ET AL.

Examiner

Zinna Northington Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 27, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. 09/807,275.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 13-23 are pending. Claims 1- 12 have been cancelled.
2. This action is in response to the Amendment filed May 27, 2005.
3. Based upon Applicant's Remarks, the rejections under 35 USC 112, 2nd paragraph are withdrawn. However, new rejections follow.
4. Based upon Applicant's Remarks, the rejection of obviousness-type double patenting rejection over US Patent 6602882 is withdrawn.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 13-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. At claims 13-18 and 21-23, the radicals Z⁴ and Z⁵ are not defined.Correction is appreciated.
 - B. Claims 19-20 improper depend upon claim 13. See the definition of Z⁴ and Z⁵.
 - C. At claim 22, the phrase " particularly, in man" is generic and subgeneric which is improper.
 - D. At claim 23, a period is needed at the end of the claim.
7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 13-23 are again provisionally rejected under the judicially created doctrine of double patenting over claims of copending Application No. 10/477,900. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

In the office action mailed January 21, 2005, see the reasons of record.

9. Claims 13-23 are again provisionally rejected under the judicially created doctrine of double patenting over claims of copending Application No. 10/484,563. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

In the office action mailed January 21, 2005, see the reasons of record.

10. Applicant's arguments have been fully considered but they are not persuasive.

Response to Applicant's Remarks About the Obviousness-Type

Double Patenting Rejection

Applicants state that Application Number 10/477900 has a provisional filing date of May 25, 2001 which is subsequent to the international publication date (April 20, 2000) of the instant application. Accordingly, Applicants believe that an obviousness-type double patenting rejection might not be a proper rejection to make in this application, and will leave the matter here for the Examiner's further consideration.

It is the Examiner's position that:

- The date of the international publication date is irrelevant to the rejection of obviousness-type double patenting.
- A double patenting rejection of obviousness-type double patenting is analogous to the nonobviousness requirement of 35 U.S.C.103 except that the patent principally underlying the double patenting rejection is not considered prior art.
- See MPEP 804.

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- The rejection under the judicially created doctrine of double patenting over claims of copending Application No. 10/477,900 is maintained.

Applicants state that Application Number 10/484563 has a provisional filing date of May 25, 2001, which is subsequent to the international publication date (April 20, 2000) of the instant application. Accordingly, Applicants believe that an obviousness-type double patenting rejection might not be a proper rejection to make in this Application, and will leave the matter here for the Examiner's further consideration.

It is the Examiner's position that:

- The date of the international publication date is irrelevant to the rejection of obviousness-type double patenting.
- A double patenting rejection of obviousness-type double patenting is analogous to the nonobviousness requirement of 35 U.S.C.103 except that the patent principally underlying the double patenting rejection is not considered prior art.
- See MPEP 804.
- The rejection under the judicially created doctrine of double patenting over claims of copending Application No. 10/484563 is maintained.

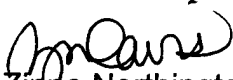
11. The Information Disclosure Statement filed May 27, 2005 has been considered. There is no teaching or suggestion in the prior art to modify the compounds to derive those instantly claimed. Accordingly, no rejections based upon prior art are made.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

13. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zinna Northington Davis
Primary Examiner
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